

ESTTA Tracking number: **ESTTA476911**

Filing date: **06/07/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	O P I Products, Inc.
Granted to Date of previous extension	06/10/2012
Address	13034 Satcoy Street North Hollywood, CA 91605 UNITED STATES
Attorney information	Dax Alvarez Blakely Sokoloff Taylor & Zafman LLP 12400 Wilshire Boulevard7th Floor Los Angeles, CA 90025-1040 UNITED STATES dax_alvarez@bstz.com Phone:3102073800

Applicant Information

Application No	85165151	Publication date	12/13/2011
Opposition Filing Date	06/07/2012	Opposition Period Ends	06/10/2012
Applicant	OPIVU Products & Cosmetics, LLC Suite A 111 Town & Country Drive Danville, CA 94526 UNITED STATES		

Goods/Services Affected by Opposition


Class 003. First Use: 2010/10/29 First Use In Commerce: 2010/10/29 All goods and services in the class are opposed, namely: Cosmetics
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1374489	Application Date	10/10/1984
Registration Date	12/10/1985	Foreign Priority Date	NONE
Word Mark	OPI		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 1983/01/01 First Use In Commerce: 1983/01/01 ACRYLIC POWDERS AND BONDING LIQUIDS FOR MAKING ARTIFICIAL FINGERNAILS AND KITS FOR MAKING ARTIFICIAL FINGERNAILS, COMPRISING ACRYLLIC POWDERS, BONDING LIQUIDS DISINFECTANTS, GLUE REMOVERS, POLISH REMOVERS, BRUSH CLEANERS, NAIL ADHESIVES, BRUSHES, DAPPER DISHES, EYE DROPPERS AND FILES, SOLD TO BEAUTY SALONS

U.S. Registration No.	2300077	Application Date	01/12/1999
Registration Date	12/14/1999	Foreign Priority Date	NONE
Word Mark	OPI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1981/00/00 First Use In Commerce: 1981/00/00 avocado based oil for treating nails and cuticles, nail lacquer, nail polish remover, cuticle cream, lipstick, lip liner, nail polish base coats, nail polish top coats and nail hardener		

U.S. Registration No.	2407311	Application Date	06/10/1999
Registration Date	11/21/2000	Foreign Priority Date	NONE
Word Mark	CLARITE' BY OPI		

Design Mark	CLARITE' BY OPI
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 1999/08/01 First Use In Commerce: 1999/08/01 acrylic powders and bonding liquids for making artificial fingernails, and kits for making artificial fingernails comprising acrylic powders and bonding liquids

U.S. Registration No.	3037202	Application Date	04/07/2004
Registration Date	01/03/2006	Foreign Priority Date	NONE
Word Mark	OPI NAIL LACQUER		
Design Mark	O P I NAIL LACQUER		
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1989/00/00 First Use In Commerce: 1989/00/00 nail lacquer		

U.S. Registration No.	3164420	Application Date	03/16/2005
Registration Date	10/31/2006	Foreign Priority Date	NONE
Word Mark	O-P-I		
Design Mark	O·P·I		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1981/00/00 First Use In Commerce: 1981/00/00 Educational services, namely training services in the field of nail care		

U.S. Registration No.	4020112	Application Date	12/17/2009
Registration Date	08/30/2011	Foreign Priority Date	NONE
Word Mark	OÂ·PÂ·I		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1991/00/00 First Use In Commerce: 1991/00/00 Cosmetics, namely, bronzing creams and powders for the body, lip gloss, lipstick, nail polish, nail strengtheners, nail hardeners, nail care preparations; artificial fingernail products, namely, overlays used for reinforcing fingernails, artificial fingernail care preparations, artificial fingernails, and adhesives for attaching artificial fingernails, eye shadows, eye pencils and eyeliners, cosmetic oils; cosmetics; bath crystals, sun tanning preparations, sun blocks, sunscreen creams, non-medicated sun protection lotions, non-medicated sun protection creams, creams and lotion for the body, lip moisturizers, non-medicated lip balms; non-medicated foot cream, skin and nail moisturizers; non-medicated protective and moisturizing skin ointments, creams and cleansers; masks, scrubs for cosmetic purposes; age-retardant creams, lotions and gels		

Attachments	73503215#TMSN.gif (1 page)(bytes) 75619421#TMSN.gif (1 page)(bytes) 75726393#TMSN.gif (1 page)(bytes) 76585869#TMSN.gif (1 page)(bytes) 76633578#TMSN.gif (1 page)(bytes) 77896293#TMSN.jpeg (1 page)(bytes) 66140.G211 Notice of Opposition.PDF (13 pages)(322220 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/dax alvarez/
Name	Dax Alvarez
Date	06/07/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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O P I Products, Inc.,)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
OPIVU Products & Cosmetics, LLC)	
)	Serial No. 85/165,151
Applicant.)	
)	
Mark: OPIVU)	
Serial No.: 85/165,151)	
Filed: October 29, 2010)	
Published: December 13, 2011)	
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NOTICE OF OPPOSITION

Opposer, O P I Products, Inc. (hereinafter "Opposer"), by and through its undersigned attorneys, opposes the application for registration of the above-referenced mark, namely, Serial No. 85/165,151, for the reason that Opposer will be damaged by the registration of the mark on the Principal Register, as set forth below:

1. Opposer, O P I Products, Inc., is a Delaware corporation located at 13034 Saticoy Street, North Hollywood, California 91605.

2. Upon information and belief, OPIVU Products & Cosmetics, LLC (hereinafter "Applicant") is a limited liability company organized under the laws of Delaware with a business address at 111 Town and Country Drive, Suite A, Danville, California 94526.

3. Opposer is the owner of the following trademarks registered on the Principal Register of the U.S. Patent and Trademark Office:

(A) OPI (Stylized), Registration No. 1,374,489

Reg. Date: 12/10/85

Goods: "acrylic powders and bonding liquids for making artificial fingernails and kits for making artificial fingernails, comprising acrylic powders, bonding liquids disinfectants, glue removers, polish removers, brush cleaners, nail adhesives, brushes, dapper dishes, eye droppers and files, sold to beauty salons";

(B) OPI, Registration No. 2,300,077

Reg. Date: 12/14/99

Goods: "avocado based oil for treating nails and cuticles, nail lacquer, nail polish remover, cuticle cream, lipstick, lip liner, nail polish base coats, nail polish top coats and nail hardener";

(C) CLARITE' BY OPI, Registration No. 2,407,311

Reg. Date: 11/21/00,

Goods: "acrylic powders and bonding liquids for making artificial fingernails, and kits for making artificial fingernails comprising acrylic powders and bonding liquids";

(D) OPI NAIL LACQUER, Registration No. 3,037,202

Reg. Date: 1/3/06

Goods: "nail lacquer";

(E) O·P·I, Registration No. 3,164,420

Reg. Date: 10/31/06

Services: "educational services, namely training services in the field of nail care."

(F) O·P·I, Registration No. 4,020,112

Reg. Date: 8/30/11

Services: "cosmetics, namely, bronzing creams and powders for the body, lip gloss, lipstick, nail polish, nail strengtheners, nail hardeners, nail care preparations; artificial fingernail products, namely, overlays used for reinforcing fingernails, artificial fingernail care preparations, artificial fingernails, and adhesives for attaching artificial fingernails, eye shadows, eye pencils and eyeliners, cosmetic oils; cosmetics; bath crystals, sun tanning preparations, sun blocks, sunscreen creams, non-medicated sun protection lotions, non-medicated sun protection creams, creams and lotion for the body, lip moisturizers, non-medicated lip balms; non-medicated foot cream, skin and nail moisturizers; non-medicated protective and moisturizing skin ointments, creams and cleansers; masks, scrubs for cosmetic purposes; age-retardant creams, lotions and gels."

Copies of the registration information from the U.S. Patent and Trademark Office database are attached hereto as Exhibits "A" through "F" and incorporated herein by reference.

4. Opposer has used the mark OPI alone and with various composite marks since at least as early as 1983 in connection with a variety of beauty and nail care products and related services.

5. Opposer's trade name, OPI Products, Inc., has been in use since 1981 and is well-known in the beauty and nail care industry.

6. Opposer has developed valuable goodwill associated with its name and mark and is a leader in the beauty and nail care fields.

7. Upon information and belief, Applicant filed a use-based trademark application on or about October 29, 2010 alleging that the mark was first used anywhere and first used in interstate commerce on October 29, 2010.

8. Upon information and belief, Applicant seeks registration for the following goods:

Class 3 – Cosmetics

9. Upon information and belief, the goods for which Applicant seeks registration may be marketed in the same or similar channels as Opposer's goods and services, and in any event, the identification of goods is not limited as to market channels.

10. Applicant's U.S. Application for registration of the mark OPIVU is highly similar to Opposer's famous OPI and OPI formative marks as to be likely, when used in connection with Applicant's goods, to cause or result in dilution of Opposer's trademarks and trade name as defined in Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(d).

11. The similarities between the marks OPIVU for which Applicant seeks registration and the numerous OPI and other OPI-formative marks owned by Opposer are such that prospective purchasers or consumers of the goods of Applicant and the goods and services of the Opposer are likely to be confused, mistaken, or deceived as to the source, sponsorship or association of Applicant and Opposer and their respective goods and services.

12. The goods and services of Opposer and the goods of Applicant are closely related such that prospective purchasers are likely to believe that they emanate from a single source.

13. Upon information and belief, Applicant did not provide cosmetics displaying the mark on the date claimed in the application.

14. Upon information and belief, the mark was not in use for the goods identified in the application as claimed by the Applicant in the application at the time of filing.

15. Upon information and belief, Applicant knew or should have known that the statements that the mark was in use in interstate commerce with the goods identified in the application were false or misleading.

16. Upon information and belief, Applicant's statement that the mark was in use in commerce for the goods identified in the application constituted a knowing false representation of material fact.

17. Upon information and belief, but for the false statement in the application, the United States Patent and Trademark Office would not have approved the application for registration.

18. Due to Applicant's filing of an application for goods that it knew or should have known were not in use in commerce, Applicant committed fraud on the United States Patent and Trademark Office.

WHEREFORE, Opposer prays that U.S. Application Serial No. 85/165,151 be rejected and that the mark sought for the goods therein specified in International Class 3 be denied and refused.

Opposer herewith submits with this Notice of Opposition along with the requisite filing fee in the amount of \$300.00.

Please charge any fees or credit any overpayment to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP

Dated: June 7, 2012

By: 

Dax Alvarez
Counsel for Opposer

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025-1040
(310) 207-3800

I hereby certify that this correspondence is being transmitted electronically to the United States Patent and Trademark Office on June 7, 2012.


Christina Cigliano

June 7, 2012

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document filed via the Electronic System for Trademark Trials and Appeal Board entitled:

NOTICE OF OPPOSITION

was served on Applicant by First Class Mail, postage prepaid, in a sealed enveloped addressed as follows:

OPIVU Products & Cosmetics LLC
111 Town and Country Drive, Suite A
Danville, California 94526

John E. Russell
Allmark Trademark
2089 Avy Avenue
Menlo Park, CA 94025

Executed on June 7, 2012, at Los Angeles, California.



Christina Cigliano

Int. Cl.: 3

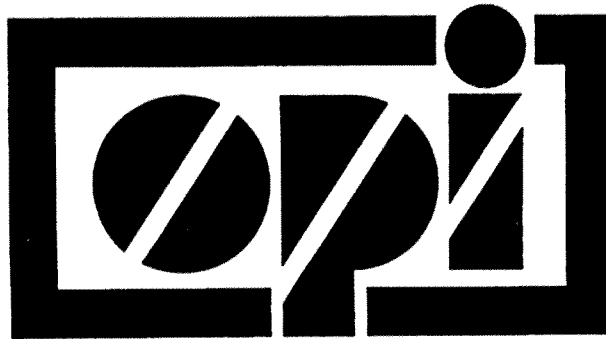
Prior U.S. Cls.: 6 and 51

United States Patent and Trademark Office

Reg. No. 1,374,489

Registered Dec. 10, 1985

**TRADEMARK
PRINCIPAL REGISTER**



OPI PRODUCTS, INC. (CALIFORNIA CORPORATION)
#30
7361 ETHEL AVENUE
NORTH HOLLYWOOD, CA 91605

FOR: ACRYLIC POWDERS AND BONDING LIQUIDS FOR MAKING ARTIFICIAL FINGERNAILS AND KITS FOR MAKING ARTIFICIAL FINGERNAILS, COMPRISING ACRYLIC POWDERS, BONDING LIQUIDS DISINFECT-

ANTS, GLUE REMOVERS, POLISH REMOVERS, BRUSH CLEANERS, NAIL ADHESIVES, BRUSHES, DAPPER DISHES, EYE DROPPERS AND FILES, SOLD TO BEAUTY SALONS, IN CLASS 3 (U.S. CLS. 6 AND 51).

FIRST USE 1-1-1983; IN COMMERCE 1-1-1983.

SER. NO. 503,215, FILED 10-10-1984.

GARY L. SHAFFER, EXAMINING ATTORNEY

Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51 and 52

United States Patent and Trademark Office

Reg. No. 2,300,077

Registered Dec. 14, 1999

**TRADEMARK
PRINCIPAL REGISTER**

OPI

OPI PRODUCTS, INC. (CALIFORNIA CORPORATION)
13034 SATICOY STREET
NORTH HOLLYWOOD, CA 91605

FOR: AVOCADO BASED OIL FOR TREATING NAILS AND CUTICLES, NAIL LACQUER, NAIL POLISH REMOVER, CUTICLE CREAM, LIPSTICK, LIP LINER, NAIL POLISH BASE COATS, NAIL POLISH TOP COATS AND NAIL

HARDENER, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 0-0-1981; IN COMMERCE 0-0-1981.

OWNER OF U.S. REG. NOS. 1,374,489, 1,412,881, AND 1,813,313.

SER. NO. 75-619,421, FILED 1-12-1999.

ANDREA KOYNER, EXAMINING ATTORNEY

Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51, and 52

Reg. No. 2,407,311

United States Patent and Trademark Office

Registered Nov. 21, 2000

**TRADEMARK
PRINCIPAL REGISTER**

CLARITE' BY OPI

OPI PRODUCTS, INC. (CALIFORNIA CORPORATION)
13034 SATICOY STREET
NORTH HOLLYWOOD, CA 91605

FOR: ACRYLIC POWDERS AND BONDING LIQUIDS FOR MAKING ARTIFICIAL FINGERNAILS, AND KITS FOR MAKING ARTIFICIAL FINGER-

NAILS COMPRISING ACRYLIC POWDERS AND BONDING LIQUIDS, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 8-1-1999; IN COMMERCE 8-1-1999.

SN 75-726,393, FILED 6-10-1999.

LINDA E. BLOHM, EXAMINING ATTORNEY

Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51 and 52

United States Patent and Trademark Office

Reg. No. 3,037,202

Registered Jan. 3, 2006

**TRADEMARK
PRINCIPAL REGISTER**

O P I NAIL LACQUER

OPI PRODUCTS, INC. (CALIFORNIA CORPORATION)
13034 SATICOY STREET
NORTH HOLLYWOOD, CA 91605

OWNER OF U.S. REG. NOS. 1,374,489, 1,412,881,
AND 2,300,077.

FOR: NAIL LACQUER, IN CLASS 3 (U.S. CLS. 1, 4,
6, 50, 51 AND 52).

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "NAIL LACQUER", APART FROM
THE MARK AS SHOWN.

FIRST USE 0-0-1989; IN COMMERCE 0-0-1989.

SER. NO. 76-585,869, FILED 4-7-2004.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

HENRY S. ZAK, EXAMINING ATTORNEY

Int. Cl.: 41

Prior U.S. Cls.: 100, 101 and 107

United States Patent and Trademark Office

Reg. No. 3,164,420

Registered Oct. 31, 2006

**SERVICE MARK
PRINCIPAL REGISTER**

O·P·I

OPI PRODUCTS, INC. (CALIFORNIA CORPORATION)

13034 SATICOY STREET

NORTH HOLLYWOOD, CA 91605

FOR: EDUCATIONAL SERVICES, NAMELY
TRAINING SERVICES IN THE FIELD OF NAIL
CARE, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 0-0-1981; IN COMMERCE 0-0-1981.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 2,300,077, 2,862,306
AND OTHERS.

SER. NO. 76-633,578, FILED 3-16-2005.

MICHAEL TANNER, EXAMINING ATTORNEY

United States of America

United States Patent and Trademark Office

O·P·I

Reg. No. 4,020,112

Registered Aug. 30, 2011

Int. Cl.: 3

TRADEMARK

PRINCIPAL REGISTER

OPI PRODUCTS, INC. (DELAWARE CORPORATION)
13034 SATICOY STREET
NORTH HOLLYWOOD, CA 91605

FOR: COSMETICS, NAMELY, BRONZING CREAMS AND POWDERS FOR THE BODY, LIP GLOSS, LIPSTICK, NAIL POLISH, NAIL STRENGTHENERS, NAIL HARDENERS, NAIL CARE PREPARATIONS; ARTIFICIAL FINGERNAIL PRODUCTS, NAMELY, OVERLAYS USED FOR REINFORCING FINGERNAILS, ARTIFICIAL FINGERNAIL CARE PREPARATIONS, ARTIFICIAL FINGERNAILS, AND ADHESIVES FOR ATTACHING ARTIFICIAL FINGERNAILS, EYE SHADOWS, EYE PENCILS AND EYELINERS, COSMETIC OILS; COSMETICS; BATH CRYSTALS, SUN TANNING PREPARATIONS, SUN BLOCKS, SUN-SCREEN CREAMS, NON-MEDICATED SUN PROTECTION LOTIONS, NON-MEDICATED SUN PROTECTION CREAMS, CREAMS AND LOTION FOR THE BODY, LIP MOISTURIZERS, NON-MEDICATED LIP BALMS, NON-MEDICATED FOOT CREAM, SKIN AND NAIL MOISTURIZERS; NON-MEDICATED PROTECTIVE AND MOISTURIZING SKIN OINTMENTS, CREAMS AND CLEANSERS; MASKS, SCRUBS FOR COSMETIC PURPOSES; AGE-RETARDANT CREAMS, LOTIONS AND GELS, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 0-0-1991; IN COMMERCE 0-0-1991.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 1,813,313, 3,164,420, AND OTHERS.

SN 77-896,293, FILED 12-17-2009.

MARK PILARO, EXAMINING ATTORNEY



David J. Kypos

Director of the United States Patent and Trademark Office